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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,471

08/31/2006

Makoto Ouchi

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OLIFF & BERRIDGE, PLC

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ALEXANDRIA, VA 22320-4850

EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,471	Applicant(s) OUCHI ET AL.	
	Examiner MICHAEL M. BERNSHTEYN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/22/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi (JP 2003-128900) in view of Omura et al. (JP 55-131047).

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With regard to the limitations of claims 1, 2, 4-6 and 8, Takagi discloses that automobile parts and electric appliance parts contain **a lactic acid resin composition** as a major component and shredder dust comes from automobile parts and electric appliance parts containing a lactic acid resin composition. The lactic acid resin composition comprises: (1) 30-100% of a lactic acid resin, (2) 0-50 wt.% of an aliphatic polyester having Tg of 0°C and/or an aromatic aliphatic polyester, (3) 0-50 wt.% of an inorganic filler, (4) 0-10 wt.% of a hydrolysis preventing agent and (5) 0-50 wt.% of a plasticizer (abstract).

Takagi discloses that the lactic-acid system resin may mean poly-DL [the poly-L-lactic acid whose structural unit is L-lactic acid, the poly-D-lactic acid whose structural unit is D-lactic acid, and whose structural unit are L-lactic acid and D-lactic acid]-lactic acids, and these mixtures, and may be a copolymer with alpha-hydroxycarboxylic acid, or diol/dicarboxylic acid further. However, it is important that DL configuration of lactic-acid system resin is L body:D object = 100:0-90:10 or L body:D object = 0:100-10:90. If it is out of range, the thermal resistance of components is hard to be obtained (page 3, [0011]). As a polymerization method of lactic-acid system resin, any well-known approaches, such as a condensation polymerization method and a ring-opening-polymerization method, are employable, for example, a condensation polymerization method (page 11, [0012]).

With regard to the limitations of claim 3, Takagi discloses that the most desirable thing as copolymerization is **block copolymerization**. It can consider as the polymer possessing transparency and shock resistance by making a polylactic acid segment into

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an ABA block copolymer typically, if A, for example, a diol dicarboxylic acid segment, is set to B. In this case, as for the glass transition temperature (T_g) of the segment of B, it is desirable that it is 0°C or less, when discovering shock resistance (page 3, [0017]).

With regard to the limitations of claims 1, 4-6, and 8-14, Takagi does not disclose that that the polylactic acid resin composition comprises as aromatic urea compound represented by formula (1).

With regard to the limitations of claims 1, 4-6, and 8-14, Omura discloses that for improving the mold release and flow properties of an aromatic polyester polycarbonate, it is needed to add a specific urea compound according the claimed formula (1) to the aromatic polyester polycarbonate (abstract, Search results, pages 35-36, Answer 22 of 30).

Both references are analogous art because they are from the same field of endeavor concerning new molded articles being obtained from aromatic polyester compositions.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the mold release agent lubricant such as **xylynenebisurea** compound according the claimed formula (1) as taught by Omura in Takagi's polylactic acid resin composition in order to improve the mold release and flow properties of aromatic polyesters (JP'047, abstract, Search results, pages 35-36, Answer 22 of 30), and thus to arrive at the subject matter of instant claim 1 and dependent claims 4-6 and 8-14.

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With regard to the limitations of claim 7, the combined teaching of Takagi and Omura does not disclose the claimed properties of the polylactic acid resin composition. However, in view of substantially identical polylactic acid resin composition between Takagi, Omura and instant claims, it is the examiner position that Takagi and Omura's polylactic acid resin composition possesses these properties. Since the USPTO does not have equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. **In re Best** 195 USPQ 430, (CCPA 1977).

Even assuming that the claims are not anticipated by the reference, it would have been obvious to one of ordinary skill in the art to make the polylactic acid resin composition having the claimed properties because it appears that the reference generically embrace the claimed subject matter and the person of ordinary skill in the art would have expected all embodiments of the reference to work. Applicants have not demonstrated that the differences, if any, between the claimed subject matter and the subject matter of the prior art examples give rise to unexpected products.

Furthermore, it is noted that with regard to the limitation of the instant claim 7, the rejections is made in the sense of **In re Spada**, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that **when** the claimed compositions **are not novel**, they are not rendered patentable by recitation of properties, whether or **not** these properties are shown or suggested in prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/
Examiner, Art Unit 1796

/M. M. B./
Examiner, Art Unit 1796

/David Wu/
Supervisory Patent Examiner, Art Unit 1796